

REMARKS

This Amendment responds to Final Office Action dated June 7, 2006. Claims 20-37 are
5 pending in present application.

Regarding 35 USC §103(a) rejection of claims 20, 22-31, 33 and 35-37 as unpatentable
over Stinton (US 5204670) in view of Horton et al. (US 5615123); and claims 21, 32 and 34
over Stinton in view of Horton and Carroll (US 5266944). Applicants respectfully submit that
10 Stinton, in view of Horton et al. and Carroll, does not teach or suggest the mobile processor
communication as Examiner claimed (Final Office Action, June 7, 2006, page 7), and therefore
Applicants' claims 20, 31, and 33 (and thus claims dependent thereon) are patentably
distinguishable over cited art since requirements for establishing obviousness are unsupported
by Examiner's claims.

15 Generally, Examiner's key reference, Stinton, teaches in specifications a system
composed of: a FMD (40), a tag (44), and a CPU host (34). Stinton claims tag (or: id card (fig.
14), arm band (fig. 2)) transmits to FMD thereby composing a personnel monitoring system
(30), wherein FMD is in telecommunicative contact with CPU host. In comparison, Applicants
20 claim a mobile communications unit comprising a cellular phone physically associated with a
remote prisoner where mobile communications unit communicates wirelessly with the
processor through the digital network.

Examiner's 35 USC §103(a) obviousness rejection of Applicants' claims 20, 31, and 33
situates on Stinton's FMD (40). Examiner argues that a cellular phone (40) would be obviously
incorporated as a part of the personnel monitoring system (30) when a cellular telephone link is
established. Applicants respectfully submit that Stinton, in combination with cited references
5 or individually, fails to teach or suggest "a mobile communications unit comprising a cellular
phone physically associated with a remote prisoner."

According to MPEP Section 2142, obviousness is established when three basic criteria
are met:

10 First, there must be some suggestion or motivation, either in the references themselves
or in the knowledge generally available to one of ordinary skill in the art, to modify the
reference or to combine reference teachings.

15 Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all
the claim limitations. The teaching or suggestion to make the claimed combination and
the reasonable expectation of success must both be found in the prior art, and not based
on applicant's disclosure.

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Examiner argues that Stinton teaches or suggests cellular phone communication as
obvious within personnel monitoring system:

25 communications unit (30 of figs. 1 and 14) comprising a cellular phone (40 of fig. 1 and
40' of fig. 14), Note when a cellular telephone established (col. 21, lines 34-35), the
field monitoring device (FMD) (40 of fig. 1; and 40' of fig. 14) would be obviously
incorporated as apart of the personnel monitoring system (30 of fig. 1).

However, in distinguishing the communications unit (i.e. "transmitting" tag) from the FMD,
Stinton states, "within each remote area (32)...there is included at least one field monitoring
30 device (FMD) 40" and the "FMD receives signals from a transmitting tag unit 44" (col. 7, lines
62-66). Thus contrary to Examiner's statement, Applicants respectfully submit that FMD (40)

is not a cellular phone physically associated with a remote prisoner. Instead, Stinton teaches a personnel monitoring system with a single or collection of FMDs (40) as a monitoring device, within a remote monitoring area (32), that receives signals from a "plurality" of transmitting tags (44), each tag attached to a monitored individual (col. 8, lines 43-49).

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Therefore, Stinton in combination with cited references or individually, fail to teach or suggest to one of ordinary skill in the art at the time of invention how to modify the reference(s) to encompass a cellular phone physically associated with a remote prisoner. Thus, cited references fail to establish the first criterion for obviousness under MPEP Section 2142.

10 Rather, Stinton envisions a single or multiple FMDs per plurality of tags, contrary to a cellular phone physically associated with a remote prisoner as in Applicants' claims 20, 31, and 33.

Applicants respectfully submit that Examiner's obviousness claim is unfounded and proceed further to analyze and support the nonobviousness case below.

15 Applicants respectfully submit that Examiner's interpretation lies outside Stinton's specification; suggesting FMD and tag act together as a single communications unit. However, if tag and FMD of Stinton are indeed joined as one device (i.e. cellular phone), there would be no need for a separate FMD unit to receive a signal from the transmitting tag as claimed. Moreover, if instead, FMD and tag are separate entities on a single body, then FMD and tag are
20 mobile, which suggests no need for a fixed FMD/CPU Host communication; where remote prisoner must report in (fig. 14) at prescribed times via FMD their location and condition (col. 10 lines 31-41 and 46-57). This is specifically stated in Stinton's first independent claim limitation as:

whereby said population of individuals being monitored by said system may include both individuals like the first individual carrying a tag, and individuals like the second individual who do not carry a tag but who are obligated to regularly contact the CPU to report their status.

5 Accordingly, Stinton in combination of cited references or individually, fail to satisfy third obviousness criterion and teach or suggest all claim limitations, namely, only, a mobile communications unit comprising a cellular phone physically associated with a remote prisoner where the mobile communications unit communicates wirelessly with the processor through the
10 digital network. Additionally, references fail to enable one with ordinary skill in the art to implement a cellular phone physically attached to remote prisoner. Thus, in fulfilling these conditions, inventors such as Applicants, must invent outside of Stinton's teaching to incorporate "a mobile communications unit comprising a cellular phone physically associated with a remote prisoner" as in Applicants' specifications and claims 20, 31, and 33, that enables
15 one of ordinary skill in the art to create from specifications, a novel invention. Additionally, as found in the Federal Circuit, *In re ACS Hospital Systems, Inc. v. Monteffiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984), obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

20 Continuing with Examiner's argument, Applicants respectfully submit the following argument is misinterpreted, Examiner states:

25 Note one embodiment contemplates that there will be one FMD for every telephone within the area that is physically associated with the remote prisoner (fig. 12) to monitor sensed condition (150 of fig. 12, Note monitoring physical of the prisoner) or location according to GPS device...

According to Stinton, a telephone number is associated with area 32 (fig. 1), and an identification number is associated with FMD (40) to distinguish other FMD's in area 32 from the shared telephone line (col. 8, lines 38-42):

Thus, while the host CPU 34 will, in effect, have all such FMD's on the line at the same time once it calls the telephone number associated with the area 32, it can still "talk" to just one FMD at a time by identifying such FMD using its unique code.

Furthermore, as previously mentioned and supported in Stinton's specifications, FMD (40) functions separately from the tag (44 and 44') and cannot be combined in an obvious manner within specifications claimed. Therefore, the telephone number is associated with area 32, not with tag or FMD, in which case only the tag is physically associated with prisoner. Applicants respectfully submit that Stinton, in combination with references or individually, does not suggest why one of ordinary skill in the art would have been led to produce a cellular phone physically associated with remote prisoner. When the prior art itself provides no apparent reason for one of ordinary skill in the art to make a modification or to combine references, an argument clearly, properly exists that the claimed subject matter would not have been obvious.

Lastly, in continuing with Examiner's argument, Applicants respectfully submit that the following argument is misinterpreted, Examiner states:

the mobile communications unit/cellular phone (30 of figs. 1 and 14) communicates wirelessly with the processor (34 of figs. 1 and 14) through the digital network (col. 21, lines 34-35, Note the cellular telephone net link), thus enabling audio or visual message to be delivered electronically via the cellular phone to the remote prisoner (the telephone at the monitoring area that can be built in the monitoring system (30 of fig. 1) to communicate with the processor (34 of fig. 1).

The mobile communications unit communicates via a signal to an FMD, and then FMD in certain areas communicates to a CPU/Host via a cellular telephone link. Stinton specifically states in FIG 13B that:

the FMD/Host Communications 202 can be achieved in several ways...communication link in areas where regular telephone service is not fully established, a cellular telephone link 205 can be established. Further possible links between the FMD and the host CPU can be established using, for example, a pager 206, an RF modem 207, or a cable television (TV) communication link 208.

Thus, in view of cited references and Applicants' foregoing argument, Stinton and cited references provide no teaching or suggestion for combining the functionality of the FMD and the tag, wherein the link between functional pair communicates wirelessly with the CPU Host.

In effect, cited references fail to present a reasonable expectation of success in implementing a cellular phone physically attached to a remote prisoner. The foregoing analysis posits that cited references not only fail one condition for obviousness but all three in suggesting or teaching that Applicants' invention is unpatentable as a result of 35 USC §103(a) rejection of claims 20, 22-31, 33 and 35-37 over cited references, Stinton, Horton and Carroll.

Applicants respectfully request that Examiner reconsider rejection, since it is respectfully submitted that claims are now patentable.

Respectfully submitted,

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